

REMARKS

Claims 16-26 are pending.

Claims 16-22, 25 and 26 were rejected under 35 USC 103(a) as being unpatentable over Kurokawa in view of Machida and Kasuya. This rejection is respectfully traversed.

Independent claims 16 and 22 claim an image forming apparatus that includes a toner containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 500ppm.

Applicants previously asserted that there would have been no motivation to modify Kurokawa in view of the teachings of Kasuya to provide a toner containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 500ppm.

In response, the Examiner has stated that one would have been motivated to use the toner of Kasuya in the device of Kurokawa because such a toner “exhibits good fixing efficiency since it does not stick to a fixing member and prevents odors that may be given out during fixing.”

Applicants respectfully submit that the Examiner’s stated motivation for modifying Kurokawa ignores the actual teachings within Kurokawa and is clearly based on hindsight. Kurokawa states that it is an object of the invention to prevent deterioration of the charging member (Kurokawa, col. 3, II. 34-38). However, Kurokawa already discloses a method for remedying this problem. One of ordinary skill in the art would not look to another reference to fix a problem that has already been fixed. Specifically, Kurokawa describes using epichlorohydrin rubber on the charging member to improve the voltage resistance of the charging member (Kurokawa, col. 7, II. 14-37).

Further, Kasuya actually teaches away from Kurokawa because another stated object of Kurokawa is to reduce the cost of the apparatus itself (col. 3, ll. 34-38), and using a toner which requires an extra step (restricting the combined concentrations of an organic aromatic solvent and a vinyl monomer to not more than 500 ppm), would be contrary to that stated objective. This extra

step would increase the cost of the apparatus, not reduce costs. Thus, there would not have been any motivation to use the toner of Kasuya in the device of Kurokawa.

Still further, the Examiner has failed to provide evidence of a specific motivation to combine within the references themselves. In other words, although the Examiner has provided some reason why using the toner of Kasuya in the device of Kurokawa would be beneficial, the Examiner has not pointed to any specific disclosure in either reference which would have suggested such a desirability to one of ordinary skill in the art.

For at least the foregoing reasons, the rejection of claims 16 and 22 should be withdrawn. The rejection of claims 17-21, which depend from claims 16 and 22, should be withdrawn for at least the same reasons.

Claims 23 and 24 were rejected under 35 USC 103(a) as being unpatentable over Kurokawa in view of Machida and Kasuya, as applied to claim 16 and 22, and further in view of Masuda, U.S. Patent 5,659,854. This rejection is respectfully traversed.

As stated above, there would have been no motivation to combine Kurokawa and Kasuya in the manner suggested by the Examiner. Thus, the rejection of claims 23 and 24 should also be withdrawn.

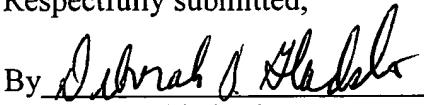
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection

with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 325772026410.

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Respectfully submitted,

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